

### **REMARKS**

Claims 1-18 are pending in this application.

Applicant has amended claims 1 and 5. The changes to claims 1 and 5 made herein do not introduce any new matter.

Applicant respectfully requests reconsideration of the rejection of claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over *Katz et al.* (U.S. Patent No. 5,926,624) in view of *Ji et al.* (U.S. Patent No. 5,889,943). As will be explained in more detail below, the combination of the *Katz et al.* and *Ji et al.* references does not raise a *prima facie* case of obviousness against independent claims 1 and 5, as amended herein.

Applicant has amended each of independent claims 1 and 5 to specify that the authentication signature is determined to be authentic when the signature can be decrypted to produce information that is coincident with a predetermined authentication reference (support for this change can be found in Applicant's specification at, for example, page 5, lines 7-9). In formulating the obviousness rejection, the Examiner acknowledges that the *Katz et al.* reference does not disclose the applying of the selected information to a preferred information buffer when the signature is determined to be authentic. The Examiner asserts, however, that the *Ji et al.* reference discloses a signature checking scheme where if a signature is authentic, the selected information is applied to a preferred information buffer. The Examiner further asserts that it would have been obvious to one having ordinary skill in the art to incorporate the preferred information buffer taught by *Ji et al.* with the authentication system taught by *Katz et al.* "in order to segregate authentic data from non authentic data." Office Action at page 2.

Applicant respectfully traverses the Examiner's characterization of the *Ji et al.* reference relative to the claimed subject matter. In contrast with the Examiner's characterization, the *Ji et al.* reference does not disclose a signature checking scheme that

determines whether a signature is authentic. Instead, the *Ji et al.* reference discloses an apparatus and method for detecting and eliminating viruses on a computer network. Further, Applicant respectfully traverses the Examiner's assertion that the *Ji et al.* reference discloses the applying of the selected information to a preferred information buffer as in the claimed subject matter. Instead, the focus of the *Ji et al.* apparatus and method is the elimination of files containing viruses, and to that end the *Ji et al.* reference temporarily stores files of the type that can contain viruses at a gateway node. If a file is determined to contain a virus, then the file can either be transferred anyway, deleted, or renamed and stored in a specified directory on the gateway node (see column 9, lines 38-44). As such, the *Ji et al.* reference does not disclose the use of a preferred information buffer as in the claimed subject matter, but rather discloses several options for handling files determined to contain a virus.

Applicant also traverses the Examiner's assertion that one having ordinary skill in the art would have been motivated to incorporate the file handling scheme shown in the *Ji et al.* reference into the system shown in *Katz et al.* In the apparatus of method shown in the *Ji et al.* reference, the FTP proxy server determines in step 610 whether the file to be transferred is of a type that can contain viruses, and this step involves checking the extension of the file name (see column 8, line 63 to column 9, line 3). This is inconsistent with the use of encrypted files as shown in the *Katz et al.* reference. Moreover, there is no need for the file handling scheme of *Ji et al.* in the *Katz et al.* system because the *Katz et al.* system functions to transfer securely digital information library programs from a library server to a client computer system and a mobile digital information playback device removably connectable to the client computer system.

In summary, the combination of the *Katz et al.* and *Ji et al.* references does not raise a *prima facie* case of obviousness against independent claims 1 and 5, as amended herein, because 1) the requisite motivation to combine the references is lacking, and 2) even if the

references were to be combined, the combination does not disclose each and every feature of the claimed subject matter.

For at least the foregoing reasons, independent claims 1 and 5, as amended herein, are patentable under 35 U.S.C. § 103(a) over the combination of *Katz et al.* in view of *Ji et al.* Claims 2-4, each of which depends from claim 1, and claims 6-8, each of which depends from claim 5, are likewise patentable under 35 U.S.C. § 103(a) over the combination of *Katz et al.* in view of *Ji et al.* for at least the same reasons set forth above regarding the applicable independent claim.

Applicant respectfully requests reconsideration of the rejection of claims 9-18 under 35 U.S.C. § 103(a) as being unpatentable over *Shanton* (U.S. Patent No. 5,680,452) in view of *Nielsen* (U.S. Patent No. US 6,453,327 B1). The *Nielsen* reference is available as prior art against the subject application under only 35 U.S.C. § 102(e). At the time the claimed subject matter was made, the *Nielsen* reference was either owned by Sun Microsystems, Inc. (the assignee of the subject application) or subject to an obligation of assignment to Sun Microsystems, Inc. (note that Sun Microsystems, Inc. is listed as the assignee on the face page of the *Nielsen* reference). Thus, pursuant to 35 U.S.C. § 103(c), the *Nielsen* reference may not be used against the subject application in an obviousness rejection. Accordingly, the rejection of claims 9-18 under 35 U.S.C. § 103(a) based on the combination of *Shanton* and *Nielsen* is improper and should be withdrawn.

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of claims 1-18, as amended herein, and submits that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 749-6902. If any additional fees are due in

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connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. SUNMP328).

Respectfully submitted,  
MARTINE PENILLA & GENCARELLA, L.L.P.

A handwritten signature in black ink, appearing to read "Peter B. Martine", with a stylized flourish extending from the end.

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